IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PHOTOGRAPHIC ILLUSTRATORS CORPORATION, Plaintiff, v. INTERNATIONAL LIGHTING CORP. D/B/A INTERLIGHT, Defendant.	***Leave to File Granted on March 6, 2015 (D.I. 24)*** Civil Action No.: 1:14-CV-14256-LTS

PLAINTIFF'S SUR-REPLY TO DEFENDANT'S MOTION TO DISMISS

Interlight's motion to dismiss should be denied because Interlight's undisputed repackaging of PIC's photographs as its own[1] is likely to cause confusion regarding the origin of those goods (i.e., photographs). Interlight's own legal authority – cited for the first time in its reply brief – confirms that, post-*Dastar*, photographs are goods that enjoy the protections of the Lanham Act.

I. Interlight "Repackaged" PIC's Goods (i.e., Photographs) As Its Own and Used Them in Commerce in Violation of 15 U.S.C. § 1125(a)(1)(A).

Interlight's reply brief argues that photographs are "communicative" in nature and therefore not "goods" (or "tangible products") subject to the Lanham Act's protections against acts likely to cause confusion about the "origin of goods." Yet both the decisions cited in PIC's opposition and the one cited for the first time in Interlight's reply brief concluded that photographs are goods (or tangible products) protected by the Lanham Act.

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[1] Interlight does not dispute that it placed its own watermark, "www.interlight.biz," over PIC's photographs. In any event, PIC's pleading of this misconduct by Interlight (*see, e.g.*, Complaint, D.I. 1, ¶¶ 24, 25, 30-109, 214-309, 447, 463) must be taken as true for purposes of this motion.

Interlight's reply brief also argues that to make out a Lanham Act violation, a plaintiff must allege that the defendant sells the good or product over which it has falsely claimed ownership. The Lanham Act, however, is broader than that. The Lanham Act prohibits a defendant's use of a false designation that is likely to cause confusion about the origin of "his or her goods, services, or commercial activities." 15 U.S.C. § 1125(a)(1)(A) (emphasis added). Both the case law cited in PIC's opposition brief and Interlight's own authority confirm that claiming ownership over a photograph (itself a good or tangible product) that is used to advertise the "product" depicted therein violates the Lanham Act.

For example, PIC cited *Defined Space, Inc. v. Lakeshore East, LLC*, 797 F. Supp. 2d 896 (N.D. Ill. 2011). In *Defined Space*, the plaintiff had taken photographs of properties belonging to the defendant real estate companies. "The defendants planned to use these photographs as part of their marketing campaign to rent and sell their properties." *Id.* at 897 (emphasis added). Just like Interlight, the defendants in *Defined Space* "[did] not sell photographs." D.I. 22 at 1. Instead, the defendants repackaged the plaintiff's photographs as their own, and used them to sell something else (in that case, real estate, in this case, lightbulbs). The court denied the defendants' motion to dismiss, holding that the defendants' conduct "cleanly fit within the exception enunciated by *Dastar*," and thus supported a Lanham Act claim. *Id.* at 901.

Interlight cites only one case, *Personal Keepsakes, Inc. v. Personalizationmall.com, Inc.*, 2012 WL 414803 (N.D. Ill. Feb. 8, 2012), in arguing that photographs are not tangible products and that *Dastar* requires a defendant to sell the repackaged goods themselves. D.I. 22 at 3. However, *Personal Keepsakes* presented different facts (use of a copied poem in a tangible gift item) and distinguished *Defined Space* and *Cable v. Agence France Presse*, 728 F. Supp. 2d 977 (N.D. Ill. 2010), also cited in PIC's opposition, in which the tangible product was the photo.

Personal Keepsakes, 2012 WL 414803, *4 (noting that in *Cable* "the news agency was simply repackaging the product at issue – the photographs – as its own" and in *Defined Space* the photos were "the full tangible product").

In yet another case, *General Scientific Corp. v. Sheervision, Inc.*, 2011 WL 3880489 (E.D. Mich. Sept. 2, 2011), the court came to the same conclusion. In *General Scientific*, the parties competed in the market for surgical loupe products, and General Scientific alleged that Sheervision had used General Scientific's "copyrighted marketing material" (namely, "a photograph and a video") to sell such products. *Id.* at *1, *3. Even though Sheervision was not selling either the photograph or the video, but rather was using those media to advertise the tangible goods depicted therein, the court denied Sheervision's motion to dismiss a Lanham Act claim because "Plaintiff has alleged a misrepresentation by Sheervision regarding the origin and nature of media used in marketing, as opposed to a misrepresentation regarding mere ideas." *Id.* at *3 (emphasis added).

Interlight's motion fails to account for the fact that photographs used to market products (whether lightbulbs as here, or surgical products as in *General Scientific*, or real estate as in *Defined Space*), regardless of whether they are "communicative" as Interlight argues, are goods. As such, the Lanham Act prohibits misrepresentation of their origin. The Supreme Court in *Dastar* confronted a different situation in which (1) the original video series was not protected by copyright and (2) the defendant's video series had changed many aspects of the original. Thus, it was literally correct for the defendant to claim its video series as its own, and the only "origin" that was arguably being misrepresented was that of the underlying idea of the series. This case, *Defined Space*, and *General Scientific* are different because they involve photographs (not mere ideas) that were copied wholesale and repackaged in a manner which misrepresents their origin.

As numerous subsequent district court decisions have concluded, the Supreme Court never foreclosed Lanham Act protection for tangible goods, like photographs, that are more than mere ideas. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (concluding that the phrase "origin of goods" does not refer to "the author of any idea, concept or communication" embodied in a tangible good).

II. Interlight Ignores Controlling First Circuit Authority on Section 1125(a)(1)(B).

The First Circuit concluded that *Dastar* does not foreclose liability for false authorship claims under 1125(a)(1)(B)'s prohibition on false advertising. *Zyla v. Wadsworth,* 360 F.3d 243, 252 n.8 (1st Cir. 2004) ("[T]he Court in *Dastar* left open the possibility that some false authorship claims could be vindicated under the auspices of § 43(a)(1)(B)'s prohibition on false advertising."). In particular, *Zyla* noted that a plaintiff would need to allege – as PIC has done – that the false claim of authorship "was a form of 'commercial advertising or promotion.'" *Id.*

PIC identified *Zyla* in its opposition brief. D.I. 19 at 8. Interlight's reply cites cases from other circuits which do not involve false claims of authorship over photographs. D.I. 22 at 4-5. Those cases are not controlling, and Interlight's reply brief fails even to mention *Zyla*.

III. PIC's Lanham Act Claims Are Not Preempted by Copyright.

Interlight's reply improperly raises an entirely new argument, namely that PIC's Lanham Act claims lack an "extra element" beyond copyright infringement, and thus are preempted by the Copyright Statute. D.I. 22 at 3-4. PIC, however, alleges a false claim of authorship which is not an element of copyright infringement. Under similar circumstances, courts have repeatedly found no preemption. *E.g.*, *Defined Space*, 797 F. Supp. 2d at 901 (rejecting preemption); *Cable*, 728 F. Supp. 2d at 981 (same); *General Scientific*, 2001 WL 3880489 at *3 (same); *Lavine v. Landy*, 832 F. Supp. 2d 176, 191 (N.D.N.Y. 2011) (with false authorship allegation, "plaintiff adequately pleads a Lanham Act claim which is not preempted by the Copyright Act").

Interlight's only preemption case involved an act of copying where an extra element was lacking because "Plaintiff does not allege that Defendants have made ... representations that they are affiliated ... with Plaintiff." *Cyber Websmith, Inc. v. Am. Dental Ass'n*, 2010 WL 3075726, *2 (N.D. Ill. Aug. 4, 2010) (emphasis original). In contrast, "PIC has pled that, because of Interlight's misconduct, customers familiar with PIC's extensive and recognizable work for Sylvania are likely to believe, incorrectly, that Interlight and PIC are affiliated, connected, or associated." (D.I. 19 at 3 (citing D.I. 1 at ¶ 465)).

IV. CONCLUSION

For the above reasons, Interlight's motion to dismiss should be denied.

Respectfully submitted,

PHOTOGRAPHIC ILLUSTRATORS CORPORATION,

By its counsel,

Dated: March 6, 2015

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CERTIFICATE OF SERVICE

I certify that this document is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF). Defendant is being served on the date of electronic filing.

/s/ *Michael N. Rader*
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